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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,921	07/07/2003	Michael Zunke	2808/12	6947

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DR. MARK M. FRIEDMAN
C/O BILL POLKINGHORN - DISCOVERY DISPATCH
9003 FLORIN WAY
UPPER MARLBORO, MD 20772

EXAMINER	
SHERR, CRISTINA O	

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
04/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mark_f@friedpat.com
friedpat@yahoo.com
sharon_l@friedpat.com

Office Action Summary	Application No.	Applicant(s)	
	10/612,921	ZUNKE ET AL.	
	Examiner	Art Unit	
	CRISTINA OWEN SHERR	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *15-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,23-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed February 2, 2009. Claims 1-24 are currently pending in this case. Claims 1-14 and 23-24 are under examination. Claims 15-22 have been withdrawn. Claims 1-5 and 15 have been amended. Claims 23-24 have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 5, 2007 has been entered.

Election/Restrictions

3. Claims 15-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 2, 2009.

Response to Arguments

4. Applicant's arguments filed June 5, 2007 have been fully considered but they are not persuasive.

5. Applicant argues, regarding claims 1-5, as currently amended, that nothing in the cited references discloses teaches or suggests, a relatively more or less tolerant licensing policy.

6. Examiner respectfully disagrees. Note that the claims, as currently amended, do not specify relative to what. Without specifying the relationship (less or more tolerant relative to what?), applicant is not further distinguishing the claims from the prior art.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. In independent claim 1 , Applicant uses the terms "relatively less" and "relatively more" tolerant without specifying relative to what. As such the claims are vague and ambiguous and fail to set forth the metes and bounds of the invention. Applicant further uses these same terms in dependent claims 2-5, For these reasons, independent claim 1 and its dependent claims 2-14 and 23-24 are rejected under section 112, second paragraph.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-14 and 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. Specifically, claims 1-14 and 23-24 are rejected because an invention that is not a machine, an article of manufacture, a composition or a process cannot be patented. *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). Also, if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. MPEP §2105.

13. In this case, independent claim 1 recites "conducting . . . . a licensing policy . . . " . . .monitoring at least one parameter . . . " , and ". . . . implementing by utilizing . . ." without ever stating who or what conducts, implements or monitors. For these reasons, independent claim 1 and its dependent claims 2-14 and 23-24 are rejected under section 101.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 1-14 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al (US 6,253,193) in view of Salas et al (US 6,314,408), further in view of Stefik et al (US 6,236,971).

16. Regarding claims 1, 23, and 24 –

17. Ginter discloses a method for determining a licensing policy of using at least one digital product by at least one user, comprising the steps of: conducting a tolerant licensing policy for the use of the at least one digital product by the at least one user during a trial period; monitoring at least one parameter of said use during said trial period (e.g. col 3 ln 20-50).

18. Ginter does not disclose, but Salas, does, determining a licensing policy according to said monitoring of said at least one parameter to obtain a determined licensing policy (e.g. col 1 ln 32-60).

19. Additionally, both Stefik at col 16 ln 59- col 17 ln 10 and Ginter at col 255 ln 57 – col 256 ln 7 disclose modification of a license by a user or users.

20. It would be obvious for one of ordinary skill in the art to combine the teachings of Ginter, Stefik and Salas as they are in the same art and in order to obtain greater flexibility in the granting of licenses.

21. Regarding claims 2-6 –

22. Ginter discloses the method of claim 1, wherein said step of monitoring includes collecting at least one sample of said at least one parameter, and wherein said step of determining includes evaluating the performance of said tolerant licensing policy according based on said at least one sample; further comprising steps of, in at least one loop, re-evaluating said determined licensing policy, and optimizing said determined policy according to said re-evaluation; wherein said tolerant licensing policy comprises at least one rule being less restrictive than a corresponding rule of said determined licensing policy; wherein said tolerant licensing policy includes free usage of the at least

one digital product during said trial period; wherein said at least one parameter is selected from a group consisting of a time count and a run count (e.g. col 48 ln 12-45).

23. Regarding claims 7-8 –

24. Ginter discloses the method of claim 6, wherein said time count is selected from the group consisting of the time of posting of a request for a license, the time a license is

25. in use by a user, and the average time a user has to wait in a licensing queue until a license is issued; wherein said run count is selected from the group consisting of the number of times licenses have been issued, the number of times a license has been requested, and the number of times a user gave up requesting a license (e.g. col 53 ln 20-50).

26. Regarding claims 9-13 –

27. Ginter discloses the method of claim 1, wherein said at. least one user is selected from the group consisting of at least one machine, at least one organization and at least one department of an organization; wherein said at least one user is defined manually; wherein said at least one user is defined automatically; wherein said at least one user is selected from the group consisting of the first N users that invoked said product during a first predefined period, the first N users that used said product for at least a predetermined duration during a predefined period, and a combination thereof; further comprising ranking said at least one user, and issuing a license to the user having the highest rank among the users waiting in a licensing queue (e.g. col 64 ln 40-55).

28. Regarding claim 14 –

29. Ginter discloses a method according to claim 13, wherein the rank of a user waiting in a licensing queue is upgraded according to the waiting time of said user in said queue (e.g. col 64 ln 50-55).

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

/CRISTINA OWEN SHERR/
Examiner, Art Unit 3685